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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/765,730

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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT

PAPER NUMBER

4172

MAIL DATE

DELIVERY MODE

01/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/765,730	Applicant(s) MILLER ET AL.	
	Examiner Christopher C. Johns	Art Unit 4172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, and 7 rejected under 35 U.S.C. 102(b) as being anticipated by the Protag Systems Inc. website, dated March 2002 (hereafter referred to as Protag).

As per claims 1, Protag discloses:

- feeding the document to a verification unit by means of an input unit, authenticating the document, releasing the document for further processing, wherein said authenticating the document is performed with a combination of at least two different verification methods (see items 1-5 - D-100, HTC-90, HTC-40, HTC-36, and HTC-35);

As per claim 2, Protag discloses:

- wherein the at least two verification methods are selected from the group comprising size verification, magnetic verification, image verification, infrared verification, UV verification, and visual verification (for example, see item #1, uses ultraviolet light, a magnetic head, and a magnifier for visual verification).

As per claim 3, Protag discloses:

- wherein the results of the verification methods are compared (this is inherent in the detectors. If the currency passes all of the checks, it is approved – this is known by comparing each of the verification methods to see if any failed, and which ones).

As per claim 4, Protag discloses:

- wherein a visual verification method is conducted (see item 1, a magnifier is used “for micro-printing verification”).

As per claim 6, Protag discloses:

- wherein the visual verification method is performed as a function of authentication certainty (the point of the system is to authenticate currency).

As per claim 7, Protag discloses:

- wherein the document is accepted with positive authentication and rejected with negative authentication (again, inherent in the definition of the system – currency is positively authenticated when the document is accepted).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Protag, in view of Official Notice.

As per claim 5, Protag discloses:

- wherein the visual verification method is performed as a function of the value of the document (the Examiner takes Official Notice that it would be obvious to one skilled in the art to not verify each and every bill that was used for payment – in order to facilitate a higher rate of speed with a lower accuracy rate, it would be obvious to leave out bills based on their value).

Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Protag, in view of *In re Harza* (124 USPQ 378, 380; 274 F.2d 669).

As per claim 8, Protag discloses:

- at least two verification stations, each of which performs a different verification process for authentication of the document (see items 1-5 - D-100, HTC-90, HTC-40, HTC-36, and HTC-35. Protag does not disclose using two units to perform different verification processes. *In re Harza* provides that “mere duplication of parts” is an obvious variant unless a new and unexpected result is produced. Therefore, due to the ruling of *In re Harza*, it would have been obvious to one skilled in the art

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at the time of the invention to combine two verification units together in tandem to perform multiple checks on the currency);

- a computer unit for comparing results of the verification stations (the units described in Protag are computer units capable of comparison as above).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patents 3,635,321, 3,870,629, 5,259,490, 5,268,582, 5,950,103, and 7,268,906, as well as US Patent Application 2001/0006556, all dealing with different document verification systems – visual, magnetic, ultraviolet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is 571-270-3462. The examiner can normally be reached on Monday-Thursday, 7:30-5, Alternate Fridays, 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Johns/
Examiner, Art Unit 4172

Christopher Johns
Examiner
Art Unit 4172

/Naeem Haq/
Primary Examiner, Art Unit 4172

Jan 08